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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,625	12/26/2001	Karl-Ulrich Stein	449122010000	8333
25227	7590	03/15/2004	EX-MINER	
MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 300 MCLEAN, VA 22102			PEREZ GUTIERREZ, RAFAEL	
ART UNIT	PAPER NUMBER			
2686				
DATE MAILED: 03/15/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/914,625	Stein	
	<b>Examiner</b>	<b>Art Unit</b>	
	Rafael Perez-Gutierrez	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 December 2001.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3,10,11,20 and 21 is/are rejected.
- 7) Claim(s) 4-9,12-19 and 22-24 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 26 December 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

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**DETAILED ACTION**

*Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

*Information Disclosure Statement*

2. The information disclosure statement filed August 31, 2001 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. In the instant application, document No. 195 28 616 A1 from Germany; document No. 692 25 925 T2 from Germany; and document No. 197 26 456 A1 from Germany have not been considered because a concise explanation of relevance has not been included for each document. All other documents cited in the information disclosure statement have been considered by the Examiner and made of record in the application file.

*Drawings*

3. The drawings are objected to because of the following minor informalities:

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a) On the single **figure**, a label identifying the figure as figure 1 (e.g., **Figure 1**) is requested since the specification refers to said figure as figure 1 (see, e.g., page 3 lines 15-19); and

b) The single **figure** lacks of descriptive labels identifying **items 3, 4, and 6**. For example, **item 3** should be labeled as --HLR--.

4. Applicant is **REQUIRED** to submit a proposed drawing correction or corrected drawings or arguments therefor in reply to this Office Action. If a response to the present Office Action fails to include proper drawing corrections or corrected drawings or arguments therefor, the response can be held **NON-RESPONSIVE** and/or the application could be **ABANDONED** since the corrections to the drawings are no longer held in abeyance.

*Specification*

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: **Claim 1** recites the limitation of “determine its position and/or status” in **line 23** and the specification only provides antecedent basis for determining the position (page 5 lines 13-16) and for determining the position and the status (page 5 lines 30-34; note especially the language of “the response signal” in lines 30 and 31 and “can then be transmitted” in line 33 which suggests that status is determined along with the position). The specification does not

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provide antecedent basis for determining the status only. Since the “determine its position and/or status” language requires determine position only, determine status only, and determine position and status, it is respectfully requested that the specification be corrected to provide antecedent basis to the “determine status only” part of the language. For purposes of applying prior art, all three embodiments are being examined (i.e., determine status, determine position, and determine position and status).

***Claim Objections***

6. **Claims 4-9, 12-19, and 22-24** are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

7. **Claim 10** is objected to because of the following informality: On line 17, replace “recorded” with --received-- in order to provide proper antecedent basis to response signals since it is recited that they were received and there is no mention of them being recorded.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

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8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless -- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claim 20** is rejected under 35 U.S.C. 102(b) as being anticipated by **Hoff (WO 96/26614)**.

Consider **claim 20**, Hoff clearly shows and discloses a remote page/cellular device 101 (mobile telephone) (figure 1) for a cellular communication system (figure 2), which device 101 (telephone) can be switched to a passive mode, in which the remote pager/cellular device 101 (telephone) is not recognizable as a normal network subscriber (i.e., the device 101 (telephone) is in a receive mode only and cellular transmitting portion 109 (figure 1) is inactive and does not transmits signals to the system, therefore, the system cannot recognize the device 101 (telephone) (abstract, page 4 lines 10-33, and page 5 lines 1-9 and 20-26)) and detects only an activation signal 211 (specific search signal) for this remote pager/cellular device 101 (mobile telephone) (abstract, page 4 lines 25-33, page 8 line 20 - page 9 line 1, page 11 lines 8-17, and page 15 lines 31-37), and then transmits (sends) a cellular (response) signal 213 in reply (abstract, figures 1 and 2, page 8 line 20 - page 9 line 1, page 12 line 29-33, page 13 lines 13-27, and page 15 line 31 - page 16 line 15).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

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obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. **Claims 1-3** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Singer et al.** (U.S. Patent # 5,485,163) in view of **Hoff (WO 96/26614)**, and further in view of **Sanmugam (U.S. Patent # 5,734,977)**.

Consider **claim 1**, Singer et al. clearly show and disclose a cellular communication system having a number of communication cells 16 (only one shown) with at least one base transceiving station (BTS) 20, 22, 24 each for wireless (cordless) communication with a large number of portable locator units (PLUs) 4, and a home location register (HLR) 36 for registration of the portable locator units (PLUs) 4 (abstract, figure 1, column 2 lines 44-67, column 3 lines 11-17 and 34-36, and column 4 lines 4-6), characterized in that at least one of the portable locator units (PLUs) 4 can be switched to a passive mode, in which it is not recognizable as a normal network subscriber (the PLU 4 is not transmitting to the

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network), and detects only an activation command (specific search signal) for this PLU 4, and then transmits (emits) a location signal (response) (abstract, figure 2, column 1 line 65 - column 2 line 3, column 2 lines 37-43, column 3 lines 47-53, and column 4 lines 4-25),

the HLR 36 has a memory (inherent) for storing PLUs 4 in the passive mode (column 3 lines 11-17 and column 4 lines 4-6);

the BTSs 20, 22, 24 are designed to send an activation command (PLU-specific search signal) in a location service (search operation) for PLUs 4 in the passive mode (abstract, figure 2, and column 4 lines 6-19);

the HLR 36 has a control device (inherent), which is designed to initiate at least one location service (search operation) at the instigation of an authorized user (column 3 line 56 - column 4 line 19), and, as a result of location (response) signals received by the BTSs 20, 22, 24 from the sought PLU 4, to determine its location (position) (column 4 lines 20-47).

However, Singer et al. do not specifically disclose that the PLU 4 is a mobile telephone.

In the same field of endeavor, Hoff clearly shows and discloses a cellular communication system (figure 2) including a remote page/cellular device 101 (locator unit/mobile telephone) (figure 1), which device 101 can be switched to a passive mode, in which the remote pager/cellular device 101 (locator unit/mobile telephone) is not recognizable as a normal network subscriber (i.e., the device 101 is in a receive mode only and cellular transmitting portion 109 (figure 1) is inactive and does not transmit signals to the system, therefore, the system cannot recognize the device 101 (abstract, page 4 lines 10-33, and page 5 lines 1-9 and 20-26)) and detects only an activation signal 211 (specific search signal) for this remote pager/cellular device

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101 (locator unit/mobile telephone) (abstract, page 4 lines 25-33, page 8 line 20 - page 9 line 1, page 11 lines 8-17, and page 15 lines 31-37), and then transmits (sends) a cellular (response) signal 213 in reply (abstract, figures 1 and 2, page 8 line 20 - page 9 line 1, page 12 line 29-33, page 13 lines 13-27, and page 15 line 31 - page 16 line 15).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide a combined mobile telephone/locator unit as taught by Hoff in the system of Singer et al. for the purpose of locating mobile telephones and provide optimal communications.

Hereinafter, the PLU 4 is being referred to as a mobile telephone.

However, Singer et al., as modified by Hoff, fail to specifically disclose determining the status or the position and status of the mobile telephone.

In the same field of endeavor, Sanmugam clearly discloses a cellular communication system in which an operator (authorized user) issues a search/locating command to a target mobile station, said mobile station, upon receiving said search/locating command via a serving mobile switching center (MSC) and corresponding base station (BS), transmits a response to the system and said system determines, from said response, the status (e.g., existence of the mobile station in a certain location) or the geographical position and status of the target mobile station (column 23 lines 8-35).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to further incorporate the feature of determining the status or the position and status as taught by Sanmugam into the system of Singer et al., as modified by Hoff, in order

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to allow the authorized user to further determine the status and the position and status of the sought mobile telephone for security and fraud detection purposes (Sanmugam; column 23 lines 1-6).

Consider **claim 2**, Singer et al., as modified by Hoff, and further modified by Sanmugam disclose the claimed invention **as applied to claim 1 above**, and in addition Singer et al. also disclose that the passive mode (mobile telephone 4 detects only an activation command (search signal) and then transmits a location signal (response signal) (abstract, figure 2, column 1 line 65 - column 2 line 9, and column 4 lines 6-32)) of the mobile telephone 4 can be switched on (e.g., when a location request for the mobile telephone is started) and off (e.g., when the location request is ended) by means of a personal identification code (PIN) (user identification code) (the PIN (user identification code) is used for accessing the location services, therefore, to access the location services and to end the location request the PIN (user identification code) must be entered) (column 3 line 65 - column 4 line 6 and column 4 lines 48-51).

Consider **claim 3**, Singer et al., as modified by Hoff, and further modified by Sanmugam disclose the claimed invention **as applied to claims 1 or 2 above**, and in addition Singer et al. further disclose that the mobile telephone 4 is switched on (i.e., receive and transmit mode) by reception of the activation command (search signal) (column 4 lines 20 and 21).

11. **Claims 10 and 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Singer et al. (U.S. Patent # 5,485,163)** in view of **Hoff (WO 96/26614)**.

Consider **claims 10 and 11**, Singer et al. clearly show and disclose a method for

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determining the location (position) of a portable locator unit (PLU) 4 in a cellular communication system, the portable locator unit (PLU) 4 being switchable to a passive mode, in which it is not recognizable as a normal network subscriber (the PLU 4 is not transmitting to the network), and detects only an activation command (specific search signal) for this PLU 4, and then transmits (emits) a location signal (response) (abstract, figures 1 and 2, column 1 line 65 - column 2 line 3, column 2 lines 37-43, column 3 lines 47-53, and column 4 lines 4-25), the PLU 4 in the passive mode being stored in the associated home location register (HLR) 36 of the cellular communications system (column 3 lines 11-17 and column 4 lines 4-6), the search operation comprises the following steps:

transmission (emission) of the activation command (specific search signal) by selected base transceiving stations (BTSs) 20, 22, 24, wherein the BTSs are chosen selectively depending on the information stored in the HLR 36 (e.g., BTSs in the proximity of the HLR 36 (column 3 lines 4-19));

reception of the location (response) signal from the sought PLU 4 by one or more BTSs 20, 22, 24 (column 4 lines 20-32);

as a result of the received location (response) signals, determination of a location (position) area where the sought PLU 4 is located (abstract, figure 2, column 1 line 65 - column 2 line 9, and column 4 lines 4-32).

However, Singer et al. do not specifically disclose that the PLU 4 is a mobile telephone.

In the same field of endeavor, Hoff clearly shows and discloses a cellular communication system (figure 2) including a remote page/cellular device 101 (locator unit/mobile telephone)

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(figure 1), which device 101 can be switched to a passive mode, in which the remote pager/cellular device 101 (locator unit/mobile telephone) is not recognizable as a normal network subscriber (i.e., the device 101 is in a receive mode only and cellular transmitting portion 109 (figure 1) is inactive and does not transmits signals to the system, therefore, the system cannot recognize the device 101 (abstract, page 4 lines 10-33, and page 5 lines 1-9 and 20-26)) and detects only an activation signal 211 (specific search signal) for this remote pager/cellular device 101 (locator unit/mobile telephone) (abstract, page 4 lines 25-33, page 8 line 20 - page 9 line 1, page 11 lines 8-17, and page 15 lines 31-37), and then transmits (sends) a cellular (response) signal 213 in reply (abstract, figures 1 and 2, page 8 line 20 - page 9 line 1, page 12 line 29-33, page 13 lines 13-27, and page 15 line 31 - page 16 line 15).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide a combined mobile telephone/locator unit as taught by Hoff in the system of Singer et al. for the purpose of locating mobile telephones and provide optimal communications.

12. **Claim 21** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Hoff (WO 96/26614)** in view of **Singer et al. (U.S. Patent # 5,485,163)**.

Consider **claim 21**, and as applied to **claim 20 above**, Hoff clearly shows and discloses the claimed invention except that the passive mode can be switched on and off by means of a user identification code.

In the same field of endeavor, Singer et al. clearly disclose a personal locator unit (PLU)

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4 operating in a cellular communication system (figure 1) having a passive mode of operation (PLU detects only an activation command (search signal) and then transmits a location signal (response signal) (abstract, figure 2, column 1 line 65 - column 2 line 9, and column 4 lines 6-32)) that can be switched on (e.g., when a location request for the PLU is started) and off (e.g., when the location request is ended) by means of a personal identification code (PIN) (user identification code) (the PIN (user identification code) is used for accessing the location services, therefore, to access the location services and to end the location request the PIN (user identification code) must be entered) (column 3 line 65 - column 4 line 6 and column 4 lines 48-51).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the feature of using a PIN (user identification code) to switch the passive mode as taught by Singer et al. into the invention of Hoff in order to allow only an authorized user or subscriber, as confirmed by the PIN (user identification number), to switch the passive mode (Singer et al.; column 3 line 65 - column 4 line 3).

### *Conclusion*

13. Any response to this Office Action should be **faxed to (703) 872-9306 or mailed to:**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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**Hand-delivered responses** should be brought to

Crystal Park II  
2021 Crystal Drive  
Arlington, VA 22202  
Sixth Floor (Receptionist)

14. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rafael Perez-Gutierrez whose telephone number is (703) 308-8996. The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700 or call customer service at (703) 306-0377.

  
Rafael Perez-Gutierrez  
R.P.G./rpg RAFAEL PEREZ-GUTIERREZ  
PATENT EXAMINER

March 10, 2004